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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,005	01/20/2004	Ehud Cohen	U 014996-9	1642

140 7590 11/01/2006

LADAS & PARRY  
26 WEST 61ST STREET  
NEW YORK, NY 10023

EXAMINER
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NATNITHITHADHA, NAVIN

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,005

Applicant(s)

COHEN ET AL.

Examiner

Navin Natnithithadha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 277-315 is/are pending in the application.
- 4a) Of the above claim(s) 302-315 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 277-301 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 302-315 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2004 02 17
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of claims 277-301 in the reply filed on 04 August 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

This application contains claims 302-315 drawn to an invention nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 277-279, 287, 288, and 291-301 are rejected under 35 U.S.C. 102(b) as being anticipated by Baudino et al, US 4,730,389 A ("Baudino").

Claims 277-279, 287, 288, and 291-301: Baudino teaches an apparatus (see Abstract and figs. 2, 3, 5, and 6) for placement in a patient, comprising:

circuitry (substrate including various electronic elements, see col. 3, ll. 41-45) 232, which is adapted to be placed in or implanted in the patient or incorporated in a

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catheter (see col. 1, ll. 51-60), wherein the circuitry comprises a sensor 12 or an active element, e.g. electrode 210 or light source 236;

a lead wire (coiled conductors) 274;

an electrically-conductive connector (capsule adapter, which includes welded sleeve 286 along with wire 248) 268, which is soldered to the circuitry (wire 248 is soldered to a conductive pad located on the ceramic substrate 232, see col. 3, ll. 55-56; and capsule adapter 268 is laser welded at its distal end to sensor body 230 and welding collar 254, see col. 4, ll. 44-46) 232, mechanically coupled to the lead wire 274 so as to be electrically coupled thereto, crimped to the lead wire (fig. 6 shows capsule 268 is crimped), and comprises a hollow tube 268 (see col. 4, ll. 46-48, wherein a portion of the lead wire 274 is disposed within the hollow tube 268 (see fig. 6), and the hollow tube 268 is crimped to the portion of the lead wire 274 (see fig. 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 280-285, 289, and 290 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino, in view of Skubitz et al, US 5,851,226 A ("Skubitz").

Claims 280-285, 289, and 290: Baudino does not explicitly teach the lead wire 274 comprises MP35N, platinum/iridium, alloys having low iron content (i.e. 1-60%, 1-40%, or 1-20% iron by weight), or silver and the connector is coated with gold or comprises steel. However, Skubitz teaches "outer conductor 55 may optionally comprise wires formed of a nickel-titanium alloy such as NITINOL.TM. [i.e. MP35N] , platinum, gold, silver, palladium, other noble metals, and other alloys [i.e. steel] or metals suitable for use in the human body. NITINOL.TM. may be purchased from Fort Wayne Metals of Fort Wayne, Ind." (see col. 16, ll. 51-62). In fact, Applicant's disclosure, on page 7, lines 27-32, admits that "these materials have proven to be both safe and effective for many applications in the human body". Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Baudino's lead wire 274 and connector 268 to comprise the materials of claims 280-284 and 289 because these materials are well known in the art to be suitable materials for use in the human body, as stated by Skubitz. *Id.*

4. Claim 286 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino, as applied to claims 277 above, in view of Delfino et al, US 6,129,658 A ("Delfino").

Claim 286: Baudino does not teach that the connector 268 has been treated with phosphoric acid. However, Delfino teaches using phosphoric acid solutions for treating implantable medical apparatuses (see col. 2, ll. 35-36). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to treat Baudino's connector 268 with phosphoric acid because Delfino discloses that "Metal-phosphate coating processes using phosphoric acid solutions are also known for depositing coatings of to prevent corrosion, lubricate, prolong the life of metal surfaces, and improve paint coating adhesion". *Id.*

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

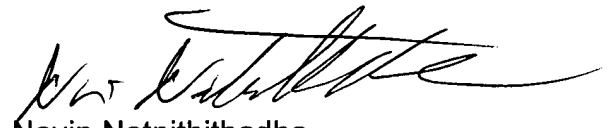
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

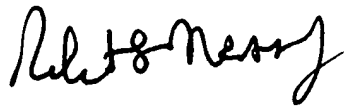
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navin Natnithithadha whose telephone number is (571) 272-4732. The examiner can normally be reached on Monday-Friday, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Navin Natnithithadha  
Patent Examiner – GAU 3735  
27 October 2006

  
ROBERT L. NASSER  
PRIMARY EXAMINER